

V. ARGUMENTS

Claims 1-6 and 8-39 are pending in the application. Claims 1, 3-6, 8-10, 13, 21 and 23-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,425,003 to Huff. Claims 1, 3-6, 8-10, 13, 21, 23-28 and 37-38 stand rejected under 35 U.S. 102(b) 5,988,760 to Durup *et al.* Claims 19 and 35 stand rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative under 35 U.S.C. 103(a) as being unpatentable over, U.S. 4,425,003 to Huff. Claims 2, 11, 20, 22 29 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,425,003 to Huff in view of U.S. Patent No. 3,953,073 to Kube. The rejections are respectfully traversed.

A. Applicants note that their prior attempt to place the claims in condition for allowance by inserting the negative limitation “in a single cavity” into the body of the claim was deemed insufficient because of the presence of the transitional verb “comprising” disposed between the preamble and the body of the claims. While Applicants disagree with the rejection, further amendments effected herein include recitation of the mentioned negative limitation *in the preamble*.

Neither Huff nor Durup *et al.* teach “A method for solution-mining a subterranean material *in an elbow well having a single cavity* ... said fluid forming a subterranean mixture with said subterranean material *within said single cavity*,” as recited in the independent claims. To the contrary, Huff expressly teaches “developing contemporaneous cavities” (see, for example, Huff at column 2, lines 58-62), and Durup *et al.* teach “eliminating” portions of the casing with “a cutting apparatus” to form a plurality of “preliminary sub-cavities” (see, for example, Durup *et al.* at column 3, lines 54-67, and column 4, at lines 1-10).

Thus, Huff and Durup *et al.* fail to teach each and every element of the claimed invention, and are therefore inappropriate for citation against the independent claims under 35 U.S.C. § 102(b) and should now be removed. Moreover, since Huff and Durup *et al.*, whether considered alone or in combination, expressly teach away from the “single cavity” element recited herein, it follows that the mentioned references are also inappropriate for citation under 35 U.S.C. § 103 and should now be removed.

Finally, since each of remaining claims 2-6, 8-20, 22, 25-29, 31-35 and 38-39 depend either directly or indirectly from one of patentably distinct independent claims 1, 21 or 37, it follows that these claims, too, are necessarily distinct and therefore allowable. *See In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

B. Alternatively, should the examiner conclude the instant amendment inserting the phrase “having a single cavity” into the preamble does not sufficiently limit the claims so as to overcome the aforementioned rejections, Applicants kindly request the Office enter a further Examiner’s Amendment changing the open-ended transitional verb “comprising” in each of independent claims 1, 21 and 37 to read “consisting of” (a closed transitional verb clause), which should inarguably place the claims in condition for allowance.

VI. CONCLUSION

In view of the foregoing, Applicants submit that each of the outstanding grounds of rejection pending in the case has been overcome and should now be removed. Reconsideration and withdrawal of the rejections, and allowance of the claims remaining in the case at an early date, are respectfully requested.

Respectfully submitted,



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